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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,306	07/07/2000	WILSON ZEHR	109912-130437	7042

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EXAMINER
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SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 12/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/581,306

**Applicant(s)**

ZEHR ET AL.

**Examiner**

Salad E Abdullahi

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Response to Amendment***

1. The Amendment filed on 9/15/2003 has been entered and made of record.
2. Applicant's arguments with respect to claims 1-15 have been considered but are not persuasive for the following reasons.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5 and 11, rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter "comparing the recipient physical address with a plurality of printing location" in claims 1, 5 and 11 are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner, interprets the above recited limitations determining a printer location *near (proximate or closest)* the recipient of the electronic content.

In addition, Maxwell discloses a system for receiving an electronic mail and sending the electronic mail to a station near the recipient of the electric content (see col.13, line 33 to col. 14, line 67).

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Maxwell  
U.S. Patent No. 5,805,810.

As per claim 1, 5, and 11, Maxwell, discloses a mail delivery system for delivering a mail to intended recipient comprising: a print server (see fig. 2, element 18) which includes: a storage device (see fig. 2, element 18); and a processor connected to the storage. device (see fig.2, element 18), the storage device storing:

a program for controlling the processor ( see col. 3, lines 20-33 and see col.5, lines 1860); and

- the processor operative with the program to receive an electronic message that includes message attributes including a message recipient and printer criteria (i.e. printer proximity) (see col.13, line 33 to col. 14, line 67);
- determine a recipient physical address responsive to the message recipient attribute contained within the electronic message (see col. 13, lines 33-50);

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- compare the message recipient physical address with the plurality of printing locations  
(that is determining a printer location *near or proximate or closest* to the recipient of the electronic content ), (see col.13, line 33 to col. 14, line 67).
- selecting a printer location near the recipient of the electronic mail (see col.13, line 33 to col. 14, line 67) and
- sending the electronic content to the selected printer location (see col.13, line 33 to col. 14, line 67).

In considering claim 4, Maxwell discloses a system, wherein the database further including a plurality of advertisements, advertising attributes and recipient demographics, in which the processor is further operative with the program to attach the selected advertisements to the electronic message (see col. 14, lines 30-35).

In considering claim 12, Maxwell discloses a system, wherein the step determining of determining proximity of plurality of printing location to the recipient of physical address (see col. 14, lines 1-67).

### Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 2, 6, 8, 9, and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell as applied to claims 1, 5 and 11 above and further in view of Yacoub U.S. Patent No. 6,452,692.

As per claims 2, 6, and 13, Maxwell is silent regarding: the print server further query the printing locations having a desired set of attributes responsive to the printing criteria responsive to the printing criteria contained with electronic message and receive replies from the printing locations responsive to the query.

Yacoub, in analogous art discloses a print server system for receiving preference for print jobs including:

the database contains attributes of a plurality of printing locations (see col. 14, lines 17-67); receiving print criteria (attributes) (see the abstract); query the printing locations having a desired set of attributes responsive to the printing criteria attributes contained within the print request (see the abstract and fig. 2, lines 28-60). select one of the printing locations (see the abstract and fig. 2, lines 28-60); and send the electronic message to the selected printing location (see the abstract and fig. 2, lines 28-60). Therefore, it would have been obvious to having ordinary skill in the art presented with teaching of Yacoub to Modify Maxwell by utilizing the print job processing mechanism as taught by Yacoub in order to enable network users to only choose job-relevant preferences such as the quality and speed without having to determine which printer to send the print job [see col. 2, lines 17-20].

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In considering claims 8, 9, and 14, Yacoub, discloses a system, wherein the information about the printer includes geographic location, printing capability or capacity (see col. 14, lines 17-67).

4. Claims 3, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell U.S. Patent No. 5,805,810, and Yacoub U.S. Patent No. 6,452,692 as applied to claims 1, 5 and 11 above, and further in view of Heiden U.S. Patent No. 6,408,286.

In considering claims 3, 10 and 15. Although, Maxwell and Yacoub disclose substantial features of the claimed invention, they are silent the database: storing a user record, said record having a counter measuring use of the mail delivery system and operative with a promotional program to effect awarding of prizes to the user. Heiden in analogous art, discloses a system a promotional program used within mail delivery system, including a user record which contains plurality of demographic information and/or indications of the behavior or status of the target audience or users (i.e. income or age and other statistics which could obviously include a measure of the system usage) (see col. 7, line 30 to col. 8, line 67). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention presented with the teaching of Heiden to modify the system presented by Maxwell and Yacoub by employing the product distribution mechanism with promotional program as taught by Heiden such that user can be rewarded with their frequent interaction with the system, thereby enhancing the mail distribution system productivity.

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **CONCLUSION**

8. The prior art made of record and relied upon is considered pertinent to the applicants disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abdullahi E. Salad** whose telephone number is **(703) 308-8441**. The examiner can normally be reached on Monday to Friday from **8:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Etienne, Ario** can be reached at **(703)308-7562**. Any inquiry of a general nature or relating to the



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status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

**Any response to this action should mailed to:**

Box AF

Commissioner of Patents and Trademarks


Washington, DC 20231

**or faxed to:**

(703) (872-9306).

**As**

11/25/2003

  
ARIEETTE HANNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100